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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,764	08/09/2001	Dusan Miljkovic	700.15-US1	5911

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EXAMINER

LEWIS, PATRICK T

ART UNIT PAPER NUMBER

1623

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/927,764

Applicant(s)

MILJKOVIC, DUSAN

Examiner

Patrick T. Lewis

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Applicant's Response dated March 15, 2004***

1. In the Response filed March 15, 2004, claims 1-20 were canceled and claims 21-30 were added.
2. Claims 21-30 are pending. An action on the merits of claims 21-30 is contained herein below.
3. The rejection of claims 13-20 under 35 U.S.C. 102(b) as being anticipated by Miljkovic et al. US 6,080,425 (Miljkovic) has been rendered moot in view of applicant's amendment dated March 15, 2004.

### ***Response to Arguments***

4. Applicant's arguments filed March 15, 2004 have been fully considered but they are not persuasive. Applicant argues that the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing being described in the reference, and that it would be so recognized by persons of ordinary skill.

Miljkovic discloses a cosmetic composition comprising a boron complex in a suitable solvent system, a microemulsion or macroemulsion form, or a suitable liposome form (column 3, lines 10-14). The boron is complexed with fructose, sorbose, mannitol, sorbitol, xylitol, ascorbic acid, serine, or threonine (column 2, lines 49-63). The compositions are preferably adapted for efficient penetration through the skin stratum corneum barrier when applied topically (column 3, lines 16-18). The compositions are

Art Unit: 1623

to be rubbed onto the skin several times per day (column 5, lines 19-28) to reduce skin wrinkles (column 2, lines 37-42). The co-extensive patient population, identical compositions employed and the similar end uses envisioned indicate that the methods of Miljkovic are necessarily present as the compositions would be expected to exhibit similar properties. Although Miljkovic does not disclose the collagenase activity of the boron-containing compounds, this is a quantification of an inherent property of the boron-containing compounds. The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Furthermore, products of identical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 21-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Miljkovic et al. US 6,080,425 (Miljkovic).

Miljkovic discloses a cosmetic composition comprising a boron complex in a suitable solvent system, a microemulsion or macroemulsion form, or a suitable liposome

Art Unit: 1623

form (column 3, lines 10-14). The boron is complexed with fructose, sorbose, mannitol, sorbitol, xylitol, ascorbic acid, serine, or threonine (column 2, lines 49-63). The compositions are preferably adapted for efficient penetration through the skin stratum corneum barrier when applied topically (column 3, lines 3-18). In a preferred embodiment, acidic boron complexes are converted to salts having sodium, potassium, magnesium or calcium as a counter ion. The compositions are to be rubbed onto the skin several times per day (column 5, lines 19-28) to reduce skin wrinkles (column 2, lines 37-42). Miljkovic does not explicitly disclose the compositions as being collagenase inhibitors; however, the co-extensive patient population, identical compositions employed and the similar end uses envisioned indicate that the methods of Miljkovic are necessarily present as the compositions would be expected to exhibit similar properties. Although Miljkovic does not disclose the collagenase activity of the boron-containing compounds, this is a quantification of an inherent property of the boron-containing compounds. The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Furthermore, products of identical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.

Art Unit: 1623

***Conclusion***

7. Claims 21-30 are pending. Claims 21-30 are rejected. No claims are allowed.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1623

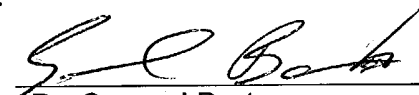
### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 571-272-0655. The examiner can normally be reached on M-F 10:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick T. Lewis, PhD  
Examiner  
Art Unit 1623

  
Dr. Samuel Barts  
Primary Patent Examiner  
Technology Center 1600

ptl  
June 1, 2004